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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,742	11/28/2001	Mario Litsche	A03517	8345

7590

03/31/2004

Kevin L. Leffel  
Heidelberg Digital L.L.C.  
2600 Manitou Road  
Rochester, NY 14624

EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,742

Applicant(s)

LITSCHÉ, MARIO

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 25-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,10-13,15-17,19 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 2,6,8,9,14,18,20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4 and 6</u> . | 6) <input type="checkbox"/> Other: ____  |

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## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, are drawn to a process of producing wire binding elements, classified in class 412, subclass 37.
- II. Claims 25-36, are drawn to an apparatus for producing wire binding elements, classified in class 140, subclass 102.

1. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as the apparatus wherein two circular discs are mounted coaxially, spaced apart and connected together, wherein each disc has wire bending pins distributed equiangularly around its periphery and project radially, wherein a lever feeds the wire around each pin, and wherein the distance between the two discs and the distance between the pivotal axis and wire bending pins of each lever may be varied to produce

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wire of various dimensions (as seen in the Schmidt et al (3,760,851) without the use of sleds or collets.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Attorney Kevin Leffel on March 16, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-24.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 25-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 3, 7, 10-13, 15, 19, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (2,190,722).

Martin discloses in Fig. 5-7, 12 and 16, a process for producing wire binding elements comprising: forming a loop in a wire (Fig. 6) with a mechanism (Fig. 13) comprising a set of connected components (4, 5, 9, 57, 6, 7 and 8), and varying the dimension of the loop by varying the at least one component (through adjustable connecting rod (56) to the lower carriage (57) carrying the shaper rod (9), as stated in Page 3, Col. 1, lines 20-25); moving at least one component (4 and 5) rectilinearly; determining a number of loops to form (Page 1, Col. 1, lines 1-3); forming a number of connected loops corresponding to a number of perforations along an edge (Page 1, Col. 1, lines 1-12 and on Page 2, Col. 2, lines 35-40); cutting wire after a determined number of connect loops are formed (Page 1, Col. 1, lines 13-16).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4, 5, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin.

Martin discloses a process of producing wire binding elements as set forth in Claims 1 and 13, and as set forth above. Martin further discloses in Fig. 6 and 7, wherein a loop is formed by moving a bending die (9) in an arc (seen in Fig.6) generated by moving one component in a rectilinearly transverse to another component.

However, Martin does not disclose the process wherein two components are moved rectilinearly transverse to form the loop.

It would have been an obvious matter of design choice to have one component to move rectilinearly transverse to another component, since applicant has not disclosed that the movement of two components provides an advantage, is used for a particular purpose, or solves a stated problem, and the invention would perform equally as well if one component moves rectilinearly to form a loop.

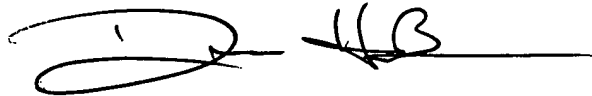
***Allowable Subject Matter***

6. Claims 2, 6, 8, 9, 14, 18, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Prior Art References*

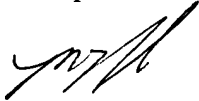
The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Calvert et al, Norman, Sage, Schmidt et al, Wang, Jones et al, Pigna et al, Cruzan, November, Aglaghanian et al, Adams, Pfaffle, Whitney, Dawson, Seaborn et al, Seaborn et al ('767), Witte, and Witte ('794) disclose a similar processes for producing wire binding elements.

Handwritten signature and initials. The signature is a stylized 'J' followed by a horizontal line. To the right of the signature are the initials 'H.B.' followed by another horizontal line.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 17, 2004



**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**